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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/551,363	09/28/2005	Earl C. Downey	01630-21317.PCT.US	3075
20551 7590 03/09/2010 THORPE NORTH & WESTERN, LLP. P.O. Box 1219 SANDY, UT 84091-1219				
EXAMINER HORNBERGER, JENNIFER LEA				
ART UNIT 3734		PAPER NUMBER		
NOTIFICATION DATE 03/09/2010		DELIVERY MODE ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary

Application No.

10/551,363

Applicant(s)

DOWNEY, EARL C.

Examiner

JENNIFER L. HORNBERGER

Art Unit

3734

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10/27/2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/CD)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. **Claims 1 and 21 are rejected under 35 U.S.C. 102(e) as being anticipated by Dumontelle (US 2004/0199195).**

Regarding claims 1 and 21, Dumontelle discloses a surgical device comprising an ergonomic handle (5) having an upper portion (see figure below) and a grip portion (see figure below), the upper portion having a handle aperture (see figure below) formed in a sidewall and accessible by a single finger of a user; a finger actuator (65) having an actuating finger receiving portion (paragraph 28) within and accessible through the handle aperture, the finger receiving portion operable with a translating shaft; an elongated tubular portion (see figure below) extending from the ergonomic handle and having a longitudinal axis; and a rod (55) functionally disposed within the tubular portion along the longitudinal axis, the rod being directly coupled proximally to the translating shaft of the finger actuator and configured to be coupled distally to a functional end (95), wherein the finger actuator moves in a non-pivoting, linear manner to directly effectuate an equidistant linear movement of the rod (paragraph 42) while maintaining a hand of the user about the ergonomic handle in a position consistent with a functional position of the hand.

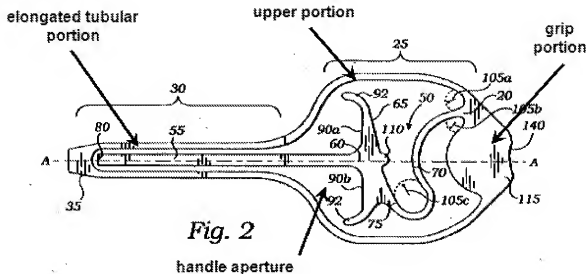


Fig. 2

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. **Claims 1, 2, 5, 6, 9-12, 15-19, and 21 are rejected under 35 U.S.C. 103(a) as being obvious over Freeman (US 6,074,408) in view of Hollender (US 3,819,091).**

Regarding claims 1, 2, 12, and 21, Freeman discloses a surgical device, comprising: an handle (16) having a finger actuator (17), the finger actuator comprising a finger receiving portion operable with a translating shaft; an elongated tubular portion (18) extending from the handle and having a longitudinal axis; and a rod (20) functionally disposed within the tubular portion along the longitudinal axis, the rod being coupled proximally to the translating shaft of the finger actuator and configured to be coupled distally to a functional end (22), wherein the finger actuator moves in a non-pivoting, linear manner to directly effectuate an equidistant linear

movement of the rod, a functional end (22; Fig. 2A-2F) coupled to a distal end of the rod, such that bidirectional pressure applied by the single finger to the finger actuator along the longitudinal axis manipulates the functional end in a bidirectional manner in a common direction to the bidirectional pressure (col. 5, ln. 10-40; col. 7, ln. 38-42).

Freeman fails to disclose a handle comprising an upper portion having a handle aperture formed in a sidewall and a finger actuator having an actuating finger receiving portion within and accessible through the handle aperture. Hollender discloses a medical device comprising an ergonomic handle having an upper portion (26) and a grip portion (28), the upper portion having a handle aperture formed in a sidewall and accessible by a single finger, a finger actuator (30) having an actuating finger receiving portion (42) within and accessible through the aperture, the finger receiving portion operable with a translating shaft, an elongated tubular member (10) extending from the ergonomic handle and having a longitudinal axis, and a rod (40) functionally disposed within the tubular portion along the longitudinal axis, the rod being directly coupled proximally to the translating shaft of the finger actuator, wherein the finger actuator moves in a non-pivoting, bi-directional, linear manner to directly effectuate an equidistant bi-directional, linear movement of the rod (Fig. 3 and 4) while maintaining a hand of the user about the ergonomic handle in a position consistent with a functional position of the hand. It would have been obvious to one of ordinary skill in the art to substitute the handle of Freeman with an ergonomic handle comprising a grip portion and an actuator located within a handle aperture in the sidewall of the upper portion of the handle as taught by Hollender since it would move the rod in the same manner as the handle of Freeman. Substitution of one known element for another element providing the same function to yield predictable results would have been obvious to one of ordinary skill in the art at the time of the invention.

Regarding claims 5 and 15, Freeman discloses the elongated tubular portion is detachable from the handle (col. 5, ln. 20-23).

Regarding claim 6, Freeman modified by Hollender disclose the ergonomic handle a shape of a pistol grip (28).

Regarding claim 8, Freeman modified by Hollender disclose a portion of the pistol grip that is substantially out of line with the longitudinal axis is detachable in the sense that it is detachable from the elongated tubular portion (col. 5, ln. 20-23).

Regarding claims 9-11 and 16-18, Freeman discloses the functional end is selected from the group consisting of a grasper, scissors, a blade, a laser and a needle holder (Fig. 2A-2F; col. 6, ln. 6-30).

Regarding claim 19, Freeman discloses a method of manipulating a surgical instrument with a single finger, comprising the following steps: grasping the surgical instrument with a hand of a user; inserting the single finger of the user into a finger actuator of the surgical instrument; moving the single finger in a direction away from the hand, causing the finger actuator to move in a non-pivoting, linear manner away from the hand to directly effectuate operation of a functional end (22); and moving the single finger in a direction toward the hand, causing the finger actuator to move in a non-pivoting, linear manner toward the hand to directly effectuate operation of the functional end (col. 5, ln. 10-40). Freeman fails to disclose the finger actuator located within and accessible through a handle aperture.

Hollender discloses a method of manipulating a surgical instrument with a single finger, comprising the steps of grasping the surgical instrument with a hand of a user; inserting a single finger into a finger receiving portion (42) of a finger actuator (30) located within and accessible through a handle aperture of an ergonomic handler of the surgical instrument; moving the single finger in a direction away from the hand, causing the finger actuator to move in a non-pivoting,

linear manner away from the hand while continually maintaining a hand of the user in a functional position about the ergonomic handle; and moving the single finger in a direction towards the hand, causing the finger actuator to move in a non-pivoting linear manner towards the hand while continually maintaining the hand of the user about the ergonomic handle in a position consistent with a functional position of the hand.

It would have been obvious to one of ordinary skill in the art to substitute the handle of Freeman with an ergonomic handle comprising a grip portion and an actuator located within a handle aperture in the sidewall of the upper portion of the handle as taught by Hollender since it would move the rod in the same manner as the handle of Freeman. Substitution of one known element for another element providing the same function to yield predictable results would have been obvious to one of ordinary skill in the art at the time of the invention.

5. Claims 3 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Freeman (US 6,074,408) in view of Hollender (US 3,819,091) as applied to claims 2 or 12 above, and further in view of Komiya (US 4,043,323).

Freeman modified by Hollender fails to disclose a ratcheting mechanism to lock the finger actuator in a fixed position, thus locking the functional end in a fixed position. Komiya disclose a ratcheting mechanism to lock a finger actuator (23) in a fixed position, thus locking the forceps (17) in a fixed position (col. 3, ln. 26-41). It would have been obvious to one of ordinary skill in the art to modify the device of Freeman modified by Hollender to include a ratcheting mechanism in order to lock the functional end in a fixed position without the operator having to maintain the position of the finger actuator.

6. Claims 4, 14, and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Freeman (US 6,074,408) in view of Hollender (US 3,819,091) as applied to claims 2, 12, or 19 above, and further in view of Rydell et al. (US 5,258,006).

Freeman modified by Hollender fails to disclose the functional end is free to rotate around the longitudinal axis or the step of rotating the functional end. Rydell et al. discloses a rotatable knob (3) for rotating forceps (12) about a longitudinal axis. It would have been obvious to one of ordinary skill in the art to modify the device of Freeman to provide a rotatable knob (or roticulator) and to rotate the knob in order to change the orientation forceps or grasping members about the longitudinal axis.

7. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Freeman (US 6,074,408) in view of Hollender (US 3,819,091) as applied to claim 6, and further in view of Cuschieri et al. (US 6,077,286).

Regarding claim 7, Freeman modified by Hollender fail to disclose the portion of the pistol grip that is substantially out of line with the longitudinal axis can be manipulated into a position that is substantially in line with the longitudinal axis. Cuschieri et al. discloses a portion of a pistol grip that is substantially out of line with the longitudinal axis and can be manipulated into a position that is substantially in line with the longitudinal axis. Cuschieri et al. discloses that the ability to adjust the handle position relative to the shaft of the instrument is ergonomically advantageous (col. 1, ln. 41-55 and col. 2, ln. 15-22). It would have been obvious to one of ordinary skill in the art to modify the device of Freeman as modified by Hollender to allow the position of the portion of the pistol grip substantially out of line with the longitudinal axis of the instrument to be adjusted relative to the longitudinal axis as suggested by Cuschieri et al. in order to allow the operator to find the most comfortable hand position for operating the instrument.

Response to Arguments

8. Applicant's arguments with respect to claims 1-21 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JENNIFER L. HORNBERGER whose telephone number is (571)270-3642. The examiner can normally be reached on Monday through Friday from 8am-5pm, Eastern time.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Todd Manahan can be reached on (571)272-4713. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

jlh
02/16/2010

/Todd E Manahan/
Supervisory Patent Examiner, Art Unit 3734